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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,143	07/23/2001	Hidegori Wada	10873.772US01	4482
7590	12/13/2005		EXAMINER	
Hamre, Schumann, Mueller & Larson P.O.Box 2902-0902 Minneapolis, MN 55402			ORTIZ CRIADO, JORGE L	
			ART UNIT	PAPER NUMBER
			2656	

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/911,143	WADA ET AL.	
	Examiner Jorge L. Ortiz-Criado	Art Unit 2656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 08 November 2005.

2a) This action is FINAL.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 32 and 33 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 32 and 33 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Claim 32 recites the limitation “a base substrate”, “a cover layer” and “a surface of the cover layer”, The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

### ***Claim Rejections - 35 USC § 112***

2. Claim 33 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 33 recite the limitation “said administrative information including at least one of a recording and reproducing condition of the optical recording medium”. The examiner cannot readily ascertain/map where in the specification as originally filed such a disclosure/support is found. Furthermore, the examiner cannot find What or How the Applicant defines administrative information. It seems that administrative information is merely information recorded in one of the layers of the disk. Hence, the limitation is considered new matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 32-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Kashiwagi U.S. Patent No. 6,175,548.

Regarding claim 32, Kashiwagi discloses an optical recording medium comprising, a base substrate (10), a cover layer (12) through which a laser beam is passed with a wavelength of 390nm to 420 nm, a first recording layer (11B) disposed between the base substrate and the cover layer; and a second recording layer (11A) disposed between the first recording layer and the cover layer, wherein a distance from a cover layer to the first recording layer is 100  $\mu\text{m} \pm 10\mu\text{m}$  (See col. 1, line 59 to col. 2, line 36; col. 3, line 64 to col. 4, line 41; Figure 2)

Regarding claim 33, Kashiwagi discloses administrative information of the optical recording medium recorded on the first recording layer, said administrative information including at least one of a recording and reproducing condition of the optical recording medium (Kashiwagi discloses that any recording or reproduction of any information is made in any layer)

***Response to Arguments***

Applicant's arguments filed 11/08/2005 have been fully considered but they are not persuasive.

Applicants argues that Kashiwagi does not disclose wherein a distance from a cover layer to the first recording layer is 100 mum  $\pm$  10mum. And, where no administrative information is found in Kashiwagi.

The examiner cannot concur because Kashiwagi discloses a distance from a cover layer to the first recording layer is 100 mum  $\pm$  10mum (See col. 1, line 59 to col. 2, line 36; col. 3, line 64 to col. 4, line 41; Figure 2) And, further the examiner cannot readily ascertain/map where in the specification What or How the Applicant defines administrative information. It seems that administrative information is merely information recorded in one of the layers of the disk, and Kashiwagi record in any layer any kind of information. Furthermore, the examiner cannot find how the desired result of having the information recorded on the disk changes the structure of the recording medium being claimed. The limitation recited must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, which in this case is record "administrative information", as claimed, then it meets the claim. In this case the claimed structure of the recording medium is met by Kashiwagi and is capable of recording any information in any layer of the recording medium.

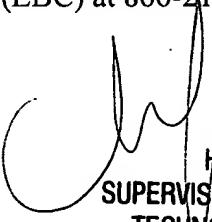
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jorge L. Ortiz-Criado whose telephone number is (571) 272-7624. The examiner can normally be reached on Mon.-Thu.(8:30 am - 6:00 pm),Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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12/10/05